

Appl. No. 09/307,485  
Amdt. dated June 24, 2003  
Reply to Office Action of [date]

PATENT

REMARKS/ARGUMENTS

In response to the Restriction Requirement mailed June 2, 2003, Applicant provisionally elects Group II, claims 5-15 and 27, with traverse. Applicant reserves the right to pursue Group I, claims 1-4 and 16-26, in a divisional application should the restriction requirement not be lifted.

Applicant notes the perplexing timing of this restriction as no less than three substantive Office Actions have rejected these claims in largely their current form. Further, an Appeal Brief has been filed in earlier prosecution of these claims. The whole restriction practice is premised on an assumption that the claims are valid, which is contrary to a case where the claims have stood rejected. "This assumption, of course, is not continued after . . . the question of patentability of the several claims in view of the prior art is taken up." MPEP; Original 8th Edition August 2001, Latest Revision February 2003; §806.02. Perhaps the restricted claims are allowable such that the validity presumption of restriction practice can still be valid.

The Office Action takes the position that Group I (related to transaction payment) is a subcombination of the Group II combination (related to auction transaction payment) noting a separate utility and classification. "The inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in other and different relations." See MPEP; Original 8th Edition August 2001, Latest Revision February 2003; §806.05(c).

To address the first prong of this test, the Office Action states that the transaction between the buyer and seller can be facilitated without the specific method of awarding a bid to a buyer as described in Group II. Applicant notes that this is not a proper application of the test as the Office Action essentially says the subcombination (i.e., Group I to transaction payment) can be facilitated without the specifics of the combination (i.e., Group II to auction transaction payment) for patentability. In other words, the Office Action switches around "subcombination"

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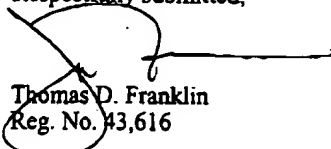
and "combination" in the test. Accordingly, Applicant believes a *prima facie* case of two way distinctness has not been demonstrated and that the restriction is accordingly improper.

CONCLUSION

In view of the foregoing, Applicants believe the restriction requirement should be lifted. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

  
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